

REMARKS

Applicants originally filed this case in 1997, and the claims have remained virtually unchanged since 1999. Applicants have twice presented this case on Appeal and fully expected the allowable claims to issue after the most recent Board decision. To Applicants' surprise, the claims now stand rejected again based primarily on the very reference addressed by the Board. And as will be discussed in greater detail below, Applicants respectfully submit that the present rejection fails to address a limitation that the Board found to distinguish the claims over the very reference that continues to be applied in the outstanding Office Action (mailed July 12, 2006). Claims 1-21 were pending and stand rejected. Applicants respectfully request reconsideration and favorable action in this case.

Claim Rejections under 35 U.S.C. § 103

Claims 1-3, 5-13, and 15-21 are Patentable Over the Proposed Schwab-Bellinger Combination

The Examiner rejects Claims 1-3, 5-13, and 15-21 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 5,973,731 to Schwab ("*Schwab*") in view of U.S. Patent No. 5,870,725 to Bellinger, et al. ("*Bellinger*"). Applicants respectfully submit that the rejection based on the proposed *Schwab-Bellinger* combination fails for two reasons – (1) the proposed combination fails to teach or suggest all elements of the claims (as confirmed by the decision of the Board of Patent Appeals and Interferences (the "Board")) and (2) there is no motivation to combine the references.

The Board's Decision Confirms that the Proposed Schwab-Bellinger Combination Fails to Teach or Suggest All Claim Elements

Applicants respectfully submit that the claims include a number of patentable distinctions, including one distinction expressly addressed by the Board in the Decision on Appeal rendered February 24, 2006. The Board's Decision directly addresses the sufficiency of the primary reference at issue – *Schwab* – holding that: "*Schwab* is completely silent as to

the video and data being sent or displayed in real time at the server computer.” *Decision on Appeal*, at 4.¹

In reopening prosecution, the Examiner introduces *Bellinger* for the aspects of Applicants' claims not shown in *Schwab*. However, *Bellinger* in no way cures the deficiencies of *Schwab*, and Applicants respectfully submit that *Bellinger* is glaringly deficient with respect to the “real-time” aspects of the claims directly addressed by the Board. In general, *Bellinger* discloses a processing system for imaging large batches of checks. See *Bellinger*, at Abstract. *Bellinger* discusses the imaging as a back-end process that occurs during a bank's reconciliation processing. *Id.* at column 11, lines 40-64. As described, the imaging of checks takes place in batch processing that occurs at the end of an account statement cycle. *Id.* This back-end, batch processing in no way teaches or suggests the real-time aspects of the claims that the Board confirmed as missing from *Schwab*.

Applicants thus respectfully submit that the proposed *Schwab-Bellinger* combination, even if proper, fails to teach or suggest all aspects of Applicants' claims. Therefore, Applicants respectfully request reconsideration and full allowance of the claims.

**There is No Teaching or Suggestion Supporting
the Combination or Modification of *Schwab* and *Bellinger***

Applicants submit that there is no teaching, suggestion, or motivation to combine or modify the teachings of *Schwab* and *Bellinger* either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. “Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available

¹ This holding falls squarely in line with numerous other decisions by the Board regarding “real-time” limitations in claims. See, e.g., *In re Weiner*, Appeal No. 2004-2228, rendered November 24, 2004 and *In re Zhang*, Appeal No. 2005-1867, rendered September 27, 2005. In *Weiner*, the claims required transmitting media to a server “in real time as it is generated by said data recording unit.” *In re Weiner*, at 2. In reversing the rejection of claim 28, the Board distinguished the real-time transmission limitation of the claims from the teaching of the cited reference, stating: “Salvati [the cited prior art reference] does not disclose -- and the system appears incompatible with -- transmission of records, as they are generated, to a central server . . .” *Id.* at 5.

to one of ordinary skill in the art.” M.P.E.P. § 2143.01. The factual inquiry whether to combine references must be thorough and searching. *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52 (Fed. Cir. 2001). This factual question cannot be resolved on subjective belief and unknown authority, but must be based on objective evidence of record. *See In re Lee*, at 277 F.3d 1338, 1343-44 (Fed. Cir. 2002).

Nothing in *Schwab* or *Bellinger* remotely suggests or motivates the proposed combination. *Schwab* discloses a system for secure identification of items or individuals taking part in transactions. *See Schwab*, at column 1, lines 9-14. *Schwab* proposes a central database of pictures that can be used for later identification of individuals or items. *Id.*, at column 1, lines 45. At the time of a transaction, a picture can be downloaded from the central server and then compared with the actual person or item. *Id.* In contrast, *Bellinger* discloses a processing system for imaging large groups of checks. *See Bellinger*, at Abstract. The imaging of checks in *Bellinger* takes place in batch processing that occurs at the end of an account statement cycle. *Id.* at column 11, lines 40-64. After examining the references, Applicants can discern no relationship between *Bellinger*'s check imaging system and *Schwab*'s secure identification technique. Applicants respectfully submit that these two references are non-analogous.

As motivation for combining *Bellinger*'s check imaging system and *Schwab*'s secure identification technique, the *Office Action* states:

[I]t would have [been] obvious with one of ordinary skill in the art to incorporate the Bellinger teaching of using video imaging of a financial transaction into the Schwab system in order to make the financial account information as accessed by either the customer or financial institution more complete by providing visual evidence of a financial transaction associated with the data file.

Office Action, at 3-4. Applicants respectfully submit that this statement both mischaracterizes the references and represents impermissible hindsight reconstruction. As discussed above, *Bellinger* discusses the imaging of checks in a back-end, batch process. *Bellinger* certainly does not have “teaching of using video imaging of a financial transaction” as asserted by the Office Action. Also, the data maintained in *Schwab*'s central database includes images of items or individuals. It is unclear how associating images of checks with these images of

items and individuals could “provid[e] visual evidence of a financial transaction associated with the data file.”

Moreover, even if the proposed combination were appropriate, a system formed from the combination of the references would provide two completely separate functions. The portion of the combined system provided by *Schwab* would help with secure identification of people or items during transactions, and the portion of the combined system provided by *Bellinger* would help banks to obtain images of checks. Applicants respectfully submit that no one of ordinary skill in the art would have been motivated to produce such a system, even if that person of ordinary skill in the art were presented with the two references. For at least these reasons, Applicants request reconsideration and withdrawal of the rejection.

Claims 4 and 14 are Patentable Over the Proposed Schwab-Bellinger-Wong Combination

The Examiner rejects Claims 4 and 14 under 35 U.S.C. § 103(a) as unpatentable over *Schwab* in view of *Bellinger* as applied above and further in view of U.S. Patent No. 5,953,347 issued to Wong (“*Wong*”). Applicants respectfully submit that this rejection fails for at least the same two reasons discussed above – (1) the proposed combination fails to teach or suggest all elements of the claims and (2) there is no motivation to combine the references.

In general, *Wong* discloses “an integrated network management system for multiple networks of different topology domains.” See *Wong*, Abstract. Applicants respectfully submit that *Wong* fails to teach or suggest any of the elements of Applicants’ independent claims discussed above. Moreover, *Wong* fails to provide any suggestion or motivation for combining the references. To the contrary, Applicants respectfully submit that *Wong* further strains any rationale for the proposed combination of *Schwab* and *Bellinger*. *Wong*’s network management system has virtually no discernable relation to either *Bellinger*’s check imaging system or *Schwab*’s secure identification technique. As with the proposed *Schwab-Bellinger* combination, Applicants submit that there is no teaching, suggestion, or motivation for the proposed *Schwab-Bellinger-Wong* combination. For at least these reasons, Applicants request reconsideration and withdrawal of the rejection.

CONCLUSION

Applicants have made an earnest attempt to place the Application in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicants respectfully request full allowance of all pending claims. If the Examiner feels that a telephone conference or an interview would advance prosecution of the Application in any manner, the undersigned attorney for Applicants stands ready to conduct such a conference at the convenience of the Examiner.

Applicants concurrently submit a Request for Extension of Time requesting an extension of one month from October 12, 2006 to November 12, 2006 and authorizing payment of the appropriate fee. Applicants believe that no other fees are due. However, the Commissioner is hereby authorized to charge any appropriate fees or credit any overpayments to Deposit Account No. 02-0384 of BAKER BOTTS L.L.P.

Respectfully submitted,

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